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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/022,863 | 12/14/2001 | Christopher Dale Fenwick | 16161 | 6252 |

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT PAPER NUMBER

3761

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,863

Applicant(s)

FENWICK ET AL.

Examiner

Jacqueline F Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/25/03 have been fully considered and they are partially persuasive. Applicant argues Periera does not disclose that the small/first denier fibers are bicomponent fibers that have a denier of 1 or less. The applicant discloses the small denier fibers have an average denier of less than or equal to 2, more particularly even less than 1 (page 13, lines 1-2). Applicant has not excluded bicomponent fibers with a denier of less than or equal to 2, and moreover, applicant has not substantiated the criticality of a denier of less than or equal to 1 as opposed to a denier of 2. Unless applicant can show criticality for claiming a particular particle size, it is not novel to claim a specific size. A modification or the disclosure of a specific size and shape does not patentably distinguish the claimed invention from the prior art.

Arguments (page 10) with respect to the Gryskiewicz reference are persuasive.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pereira USPN 6087551.

As to claim 18, Periera discloses the present invention substantially as claimed, except that Periera does not disclose the first denier fiber has an average denier of 1 or less. However, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal levels of fiber denier for a particular application.

Periera discloses a material capable of being used as a surge material for personal care products comprising between 40 and 60 weight percent of a first fiber having a first average denier and between 60 and 40 weight percent of a second fiber having a second average denier (Periera col. 2, lines 45-54), with a first fiber having an average denier at 2, and a second fiber having an average denier of 5 up to 15, Periera discloses the first fiber has an average denier at least 3 denier less than a second fiber. Periera further discloses the material has a basis weight between 30 and 200 gsm (Periera col. 4, lines 26-30).

As to claim 20, Periera discloses the nonwoven material of claim 18 wherein the second denier fiber is made from a polyester (Periera col. 2, lines 55-59).

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Periera USPN 6087551 in view of Zehner et al. USPN 5366453.

Periera discloses the nonwoven material may comprise combinations of polypropylene, polyester, and polyethylene fibers. However, Periera does not specifically disclose the nonwoven material comprises a bicomponent fiber. Zehner discloses a fluid-pervious cover layer comprising bicomponent fibers in a sheath core arrangement for the benefit of providing a soft, gentle surface for placement against the skin of a wearer (Zehner col. 8, lines 20-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nonwoven of

Periera to include a first (low) denier bicomponent fiber for the benefits disclosed in Zehner.

6. Claims 1-5 and 7-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Periera USPN 6087551 in view of Zehner et al. USPN 5366453.

Periera discloses the nonwoven material may comprise combinations of polypropylene, polyester, and polyethylene fibers. However, Periera does not specifically disclose the nonwoven material comprises a bicomponent fiber. Zehner discloses a fluid-pervious cover layer comprising bicomponent fibers in a sheath core arrangement for the benefit of providing a soft, gentle surface for placement against the skin of a wearer (Zehner col. 8, lines 20-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nonwoven of Periera to include a first (low) denier bicomponent fiber for the benefits disclosed in Zehner.

As to claim 1, Periera/Zehner discloses a nonwoven material for personal care products comprising a mixture of synthetic fibers of different denier (Periera, Abstract), wherein a first denier fiber is a bicomponent fiber (Zehner col. 8, lines 20-51) and has an average denier of 2 (Periera col. 2, lines 41-42). Periera/Zehner do not disclose the first denier fiber has an average denier of 1 or less. However, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where

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patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal levels of fiber denier for a particular application.

Periera/Zehner discloses a second fiber having an average denier between 4 and 15 (Periera col. 2, lines 43-45), therefore, with a first fiber having an average denier at 2, and a second fiber having an average denier of 5 up to 15, Periera/Zehner discloses the first fiber has an average denier at least 3 denier less than a second fiber. Periera/Zehner further discloses the material has a basis weight between 30 and 200 gsm (Periera col. 4, lines 26-30).

As to claim 2, Periera/Zehner discloses the nonwoven material of claim 1 wherein the second denier fiber has a denier between 6 and 15 (Periera col. 2, lines 43-45).

As to claim 3, Periera/Zehner discloses the nonwoven material of claim 1 wherein the first denier fiber is present in an amount between 25 and 75 weight percent and the second denier fiber is present in an amount between 75 and 25 weight percent (Periera col. 2, lines 45-54).

As to claim 4, Periera/Zehner discloses the nonwoven material of claim 1 wherein the first denier fiber is present in an amount between 40 and 60 weight percent and the second denier fiber is present in an amount between 60 and 40 weight percent (Periera col. 2, lines 45-54).

As to claim 5, Periera/Zehner discloses the nonwoven material of claim 1 wherein the first denier fiber is present in an amount of about 60 weight percent and the second denier fiber is present in an amount of about 40 weight percent (Periera col. 2, lines 45-54).

As to claim 7, Periera/Zehner discloses the nonwoven material of claim 1 wherein the first (low) denier fiber is a sheath/core bicomponent fiber selected of the group consisting of polyethylene/polypropylene, polyethylene/polyethylene terephthalate and co-polyethylene terephthalate/polyethylene terephthalate bicomponent fibers (Zehner col. 8, lines 20-51).

As to claim 8, Periera/Zehner discloses the nonwoven material of claim 1 wherein the second denier fiber is made from a polyester (Periera col. 2, lines 55-59).

As to claim 9, Periera/Zehner discloses the nonwoven material of claim 1 wherein the fibers have a hydrophilic treatment added to the surface of the fibers (Periera col. 3, lines 58-65).

As to claims 10-12, regarding the absorbent capacity and the examiner's interpretation of the test and performance characteristics of the instant apparatus claims, when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980). In the present case, the reference has met the structural requirements of claim 1 in that Periera/Zehner provides the claimed multi-denier layer comprising the claimed fiber composition capable of being used in a surge material. Therefore, the TEWL and intake rate is inherently comparable to the present invention.

As to claim 13, Periera/Zehner discloses a diaper comprising the material of claim 1 (Periera col. 4, lines 45-47).

As to claim 14, Periera/Zehner discloses a training pant comprising the material of claim 1 (Periera col. 6, lines 44-52).

As to claim 15, Periera/Zehner discloses an incontinence product comprising the material of claim 1 (Periera col. 6, lines 44-52).

As to claim 16, Periera/Zehner discloses a bandage comprising the material of claim 1 (Periera col. 6, lines 44-52).

As to claim 17, Periera/Zehner discloses a sanitary napkin comprising the material of claim 1 (Periera col. 4, lines 45-47).

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Periera USPN 6087551 in view of Zehner et al. USPN 5366453.

Periera discloses the nonwoven material may comprise combinations of polypropylene, polyester, and polyethylene fibers. However, Periera does not specifically disclose the nonwoven material comprises a bicomponent fiber. Zehner discloses a fluid-pervious cover layer comprising bicomponent fibers in a sheath core arrangement for the benefit of providing a soft, gentle surface for placement against the skin of a wearer (Zehner col. 8, lines 20-51). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the nonwoven of Periera to include a first (low) denier bicomponent fiber for the benefits disclosed in Zehner.

Periera/Zehner discloses a material capable of being used as a surge material for personal care products comprising about 60 weight percent of a first fiber (Periera

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col. 2, lines 45-54) in a bicomponent sheath/core configuration, made from polymers selected of the group consisting of polyethylene/polypropylene, polyethylene/polyethylene terephthalate and co-polyethylene terephthalate/polyethylene terephthalate (Zehner col. 8, lines 20-51) and having a first average denier, and about 40 weight percent of a polyester second fiber having a average second denier, with a first fiber having an average denier at 2, and a second fiber having an average denier of 5 up to 15, Periera/Zehner discloses the first fiber has an average denier at least 3 denier less than a second fiber. Periera/Zehner further discloses the material has a basis weight between 30 and 200 gsm (Periera col. 4, lines 26-30).

Periera/Zehner do not disclose the first denier fiber has an average denier of 1 or less. However, the specification contains no disclosure of either the critical nature of the claim limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ 2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal levels of fiber denier for a particular application.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (703) 308-8320. The examiner can normally be reached on Monday-Friday 9:00-5:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacqueline F Stephens
Examiner
Art Unit 3761



February 3, 2004



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